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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

01450015AA

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Application Number

09/986,412

Filed

November 8, 2001

First Named Inventor

M. Ikeda

Art Unit

2686

Examiner

R. Peaches

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 22,424

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

  
Signature

C. Lamont Whitham

Typed or printed name

703-787-9400

Telephone number

December 27, 2005

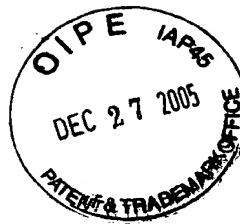
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re patent application of

Masahisa Ikeda

Serial No. 09/986,412

Filed November 8, 2001

For MOBILE TERMINAL DEVICE AND  
METHOD OF UPDATING PROGRAM

Confirmation No. 5252

Group Art Unit: No. 2686

Examiner Randy Peaches

Mail Stop AF  
Commissioner for Patents  
PO Box 1450  
Alexandria, Virginia 22313-1450

**ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

This Pre-Appeal Brief Request for Review is being concurrently filed with a Notice of Appeal. A check is attached to satisfy the fees for the Notice of Appeal. If any additional fees are required to satisfy the fees due for the Notice of Appeal or to gain entry and consideration of this Pre-Appeal Brief Request for Review, the Commissioner is authorized to charge Attorney's Deposit Account 50-2041 (Whitham, Curtis & Christofferson).

*The Invention*

As shown in Fig. 1, a mobile terminal 1, such as a cell phone, has operating system software that requires updating from time-to-time from a base station 2. This is done by RF transmission 3, but such transmission is subject to interruption. Reference is made to the drawing figures attached to the English language translation of the priority document submitted with the amendment filed 8/30/04, as these figures have legends. As described on page 4, third paragraph, of that amendment, normal operation software is stored in storage area 1A, while update data is downloaded to storage area 1C until the update data download is completed and installed. To account for possible interruptions in the download

process, the update data is divided into a plurality of sequential data sets by the base station, which data sets are associated with corresponding pointers. As described at page 4, third paragraph, in the amendment filed 8/9/05, incomplete downloads may be remedied by repeating downloading of only those data sets not fully downloaded, rather than repeating the downloading of all the update data. Arithmetic unit 1D verifies the pointer of each complete update data set and determines the pointer for the next data set which should be received next. After all update data is downloaded, an operation test is automatically started.

#### *Errors and Omissions*

The Examiner has failed to make out a *prima facie* case of obviousness under 35 U.S.C. § 103 but has, instead, relied on hindsight in an attempt to piece together several disparate references to arrive at his conclusion of obviousness. Specifically, the Examiner rejects claims 1, 4, 6, 8 and 9 on USP 6,687,901 to Imamatsu, EP 0 802 694 to Heidari, USP 6,425,125 to Fries et al. and USP 6,658,247 to Saito and rejects claims 3 and 5 on the references to Imamatsu, Heidari and Saito. On its face the second rejection is in error since claims 3 and 5 are either directly or indirectly dependent on claim 1; therefore, the rejection of those claims must also include the Fries et al. reference.

The Examiner states “Imamatsu does not disclose transmitting the said downloaded software from the said base station to the said terminal device”, Office Action mailed 11/2/05, page 3. The Examiner relies on Heidari for a teaching “of transmitting programs from the said base station to the mobile telephone”, but further states that “the combination of Imamatsu and Heidari fail to disclose wherein an arithmetic unit verifies a pointer of a completely received final update data set and determines a next pointer in connection with the next data set, which should be received next” (Office Action mailed 11/2/05, page 3). The Examiner relies on Fries et al. for a teaching “wherein a final update of data is a program where an update server compares the old character string of the new version in order to identify matching section of a download”, but the Examiner continues, stating that “the combination of Imamatsu, Heidari and Fries et al. fails

to expressly disclose where in said transmission blocks a plural [sic] of pointers are added” (Office Action mailed 11/2/05, pages 3 and 4). The Examiner relies on Saito for a teaching of “load counters ‘n’ and bit counters ‘m’, which reads on claimed ‘pointers’, that are used to determine which block of transmitted data should be downloaded during re-transmission.” The Examiner has failed to demonstrate that the several references are directed to the same technology and that there is motivation to make the combination he has proposed independent of Applicant’s own disclosure.

Reference is made to the arguments presented on pages 5 and 6 of the amendment filed 8/30/04 concerning the combination of Imamatsu and Heidari. Reference is made to the arguments presented on pages 6 and 7 of the amendment filed 8/30/04 concerning the combination of Imamatsu, Heidari and Saito. Reference is made to arguments on pages 5 and 6 of the amendment filed 8/9/05 concerning the addition Fries et al. to the combination of Imamatsu, Heidari and Saito.

Imamatsu updates software in a terminal device. The update software 203 is not stored before installation but is instead downloaded directly through buffer memory 206 to the control software portion 204 of main memory 202. The Heidari mobile phone stores two sets of protocols in separate program memories 66 and 68 so that the computer 58 may switch between protocols as may be required in transitioning between cells using different protocols. Fries et al. describe a process that identifies sections of a program that are to be upgraded. Saito is concerned with downloading music data to a cell phone and provides for interruption and subsequent restarting of music transmissions when calls are taken.

There is no reason to combine Imamatsu, Heidari, Fries et al. and Saito, and even if these disparate references could somehow be combined, the combination would not result in the claimed invention. At best, the combination would be a cell phone in which software is updated (Imamatsu) and separate protocols are stored to provide compatibility between cells using different protocols (Heidari) wherein in the software is only updated in those sections that are to be upgraded (Fries et al.) and additionally allows for the downloading of

music.

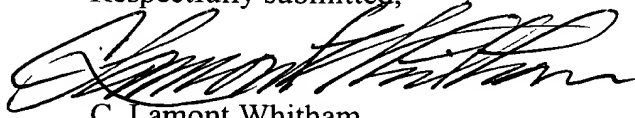
None of the references, taken singly or in combination, recognize the problem solved by the claimed invention, which is the updating of a control program in a mobile device wherein transmission of the update data is subject to interruption but avoids having to repeat the entire transmission process and verifies the update data. The invention first divides the update data into a plurality of sequential data sets which are identified by pointers. Once a data set has been downloaded to a separate memory within mobile device, the arithmetic unit verifies the downloaded data has been received and determines the next pointer in the sequence for downloading the next data set (Claim 1). This process is continued until all data sets of the sequence have been downloaded. If there is an interruption during the download process, once re-connection is made to the base station, the download process resumes with the next data set in the sequence which was not completely downloaded before the interruption (Claims 3 and 6). After all the update data is transmitted, an operation test is automatically started (Claims 4, 5 and 8). Once the test is completed, the updated program is re-written into an existent program (Claim 9).

### *Conclusion*

The Examiner has failed to make out a *prima facie* case of obviousness in his rejection of the claims. Instead, he has relied solely on hindsight to piece together disparate references without a showing of motivation independent of Applicant's own disclosure for making the combination. Therefore, the rejections of the claims are clearly in error.

In view of the above, it is requested that the position of the Examiner be reviewed, that the rejections be withdrawn, and that the application be passed to issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'C. Lamont Whitham', written in a cursive style.

C. Lamont Whitham

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